

REMARKS

Summary of Office Action

Claims 1-130 are pending in the above-identified application.

Claims 97-106 were withdrawn from consideration as being drawn to a nonelected invention.

Claims 123-130 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jaeb et al. U.S. Patent Application Publication No. 2002/0003095 (hereinafter "Jaeb").

Claims 1-36, 38-63, 65-93, 95-96 and 107-122 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jaeb.

Claims 37, 64 and 94 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jaeb in view of Lax U.S. Patent No. 5,988,376 (hereinafter "Lax").

Summary of Applicants' Reply

Applicants have amended claims 123 and 127 to make minor grammatical changes.

Applicants traverse the Examiner's rejections under 35 U.S.C. § 102(b) of claims 123-130.

Applicants traverse the Examiner's rejections under 35 U.S.C. § 103(a) of claims 1-96 and 107-122.

**Applicants' Reply to the § 102(b)
Rejection of Claims 123-130**

Claims 123-130 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jaeb. Independent claims 123 and 127 are respectively directed to apparatus for locking or unlocking a container and a method for locking or unlocking a container. Claims 124-126 depend from claim 123 and claims 128-130 depend from claim 127.

The Examiner alleged that Jaeb element 18 (an elongated slide) and Jaeb element 72 (a biased leaf-spring) respectively correspond to the claimed "locking member" and "magnetically attractable portion". Apparatus claim 123 requires "[a] locking member [that] has at least one magnetically attractable portion". Jaeb element 18 does not "have" a magnetically attractable portion, because Jaeb element 72 is attached to Jaeb top wall 30. (See Jaeb FIGS. 13-14 and para. 39).

Claims 123 further requires a "magnetic arrangement [that] is configured to hold...the...magnetically attractable portion of the locking member within a magnetic field...while the container slides through the channel..." Because the

claimed locking member "has" the magnetically attractable portion, the claimed locking member also is held by the magnetic field when the claimed magnetically attractable portion is so held. Both the claimed locking member and the claimed magnetically attractable portion are thus magnetically held while the container slides through the channel. Jaeb magnet 90 holds Jaeb element 72, but Jaeb teaches that slide 18 is mechanically—not magnetically—held by pin 92 while container 10 slides.

Applicants respectfully submit, therefore, that because Jaeb does not show or suggest the required "locking member [that] has at least one magnetically attractable portion" (emphasis added), Jaeb does not anticipate apparatus claim 123 or, by analogy, method claim 127. Applicants respectfully request that the Examiner withdraw the rejections of claims 123 and 127 along with the rejections of claims 124-126 and 128-130, which respectively depend from claims 123 and 127.

**Applicants' Reply to the § 103(a) Rejection
of Claims 1-36, 38-63, 65-93, 95-96 and 107-122**

Claims 1-36, 38-63, 65-93, 95-96 and 107-122 were rejected under 35 U.S.C. § 103(a) as being anticipated by Jaeb.

Applicants' independent claims 1, 39, 66, 96, 107-110 and 122, and dependent claims 2-36, 38, 40-63, 65, 67-93, 95, and 111-121, which depend from claims 1, 39, 66, 96 and 107-110, are directed to systems and methods for locking and unlocking an item in a container. All of the aforementioned claims require a locking member that may be moved from an unlocked position to a locked position, and that "the entirety of the locking member be internal to the container" when the locking member is in the unlocked position.

The Examiner conceded that Jaeb does not show applicants' claimed requirement that "the entirety of the locking member [be] internal to the container in the unlocked position", but alleged that it would have been obvious "to omit [Jaeb's] actuation member from the end of [Jaeb's] locking member, and actuate the locking member by means of Jaeb's unlocking pin...to move the locking member into both the locked and unlocked positions..." Office Action at p. 6 (emphasis added).

Instead of alleging that there is in the art a motivation for the proposed modification (viz., the omission of a portion) of the Jaeb device, the Examiner applied to applicants' claims the reasoning of the *In re Karlson* court,

which stated that "omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art." *In re Karlson*, 136 USPQ 184, 186 (CCPA January 16, 1963).

Applicants assert that the *In re Karlson* court upheld an obviousness rejection of Karlson's claim, which (1) omitted an improvement that was shown in the prior art Shuldener patent; and (2) was shown *in toto* in the patent. Had the Shuldener improvement actually been omitted from the Shuldener apparatus, the remaining elements of the Shuldener apparatus would have retained their functions. *In re Karlson* at 136 (... "no change in the functions of the remaining elements would result from the omission..."). Because the remaining elements would have anticipated—and provided the same functionality as the invention defined by—Karlson's claim, there was a strong suggestion to modify the Shuldener device to arrive at Karlson's claimed invention. *In re Karlson* at 136 (reasoning that "[i]f it were thought desirable to [use the Shuldener device to] dissolve the solid chemical in the lower portion of the [Shuldener] tank, elimination of the [Shuldener improvement] would seem to be suggested.")

In the instant application, the Examiner's proposed modification of Jaeb would require that the Jaeb unlocking pin become an "unlocking-and-locking" pin. The proposed omission would therefore require that the remaining Jaeb elements perform different functions after the omission and therefore *In re* Karlson can not be applied to the instant application and does not support the Examiner's rejection. For at least this reason, applicants assert that the Examiner has not established *prima facie* obviousness of applicants' claims and that the claims are not obvious from Jaeb.

Applicants further assert that the Examiner's proposed modification would render the Jaeb device inoperable for its intended purposes. The Jaeb teachings excerpted in the table below show that the intended purposes of the Jaeb container, in conjunction with Jaeb slide 18, are to be easily lockable by apparatus acting on a portion of slide 18 that protrudes outside the Jaeb container and to deny a shoplifter an opportunity to pry open the container.

Jaeb Teaching	Jaeb Para. No.
"The protruding portion of main wall 60 allows slide 18 to be locked by automated equipment after an item of recorded media has been loaded into the storage compartment of security storage container 10."	40

Jaeb Teaching	Jaeb Para. No.
"The...locking process may be easily achieved by automated equipment because of the relatively simple movements required to...lock security storage container 10."	41
"The locking mechanism of the security box may be locked...with automated equipment because the motions required to close and lock the box are relatively simple."	44
FIG. 3 shows that in the locked configuration, an end of slide 18 is flush with sidewall 32, thus "providing no areas that may be easily attacked with a pry bar."	44

The Examiner's proposed modification would render the Jaeb device unable to be locked by apparatus acting on a portion of slide 18 that protrudes outside the Jaeb container, because the protruding portion would be omitted. The proposed modification also would render the Jaeb device unable to deny a shoplifter an opportunity to pry the container open, because omission of the protruding portion would leave an opening in Jaeb sidewall 32 when the container is locked. (See Jaeb FIG. 3 (showing end of slide 18 flush with sidewall 32 when container is locked).) Applicants assert that for at least these reasons the Examiner has not established *prima facie* obviousness of applicants' claims, because there is no suggestion to make a proposed modification when the device as modified would be rendered

inoperable for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

For at least the foregoing reasons, applicants respectfully assert that claims 1-36, 38-63, 65-93, 95-96 and 107-122 are not obvious from Jaeb and request that the Examiner withdraw the rejections of the claims.

Applicants' Reply to the § 103(a) Rejection over Jaeb in view of Lax of Claims 37, 64 and 94

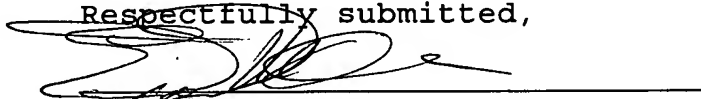
Claims 37, 64 and 94 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jaeb in view of Lax.

Claims 37, 64 and 94 depend indirectly from independent claims 1, 39 and 66, respectively. As discussed above, claims 1, 39 and 66 are patentable over Jaeb, because modification of Jaeb to meet the requirements of claims 1, 39 and 66 would render the Jaeb device inoperable and therefore there can be no motivation to modify Jaeb. The teachings of Lax do not include a motivation to modify the Jaeb device, whether such modification would render Jaeb inoperable or not, so claims 1, 39 and 66 are not obvious from Jaeb in view of Lax. Applicants therefore respectfully request that the Examiner's rejection of claims 37, 64 and 94 be withdrawn.

Conclusion

Applicants respectfully submit that, for at least the foregoing reasons, claims 1-96 and 107-130 are patentable and that this application is in condition for allowance. Reconsideration and prompt allowance are respectfully requested.

Respectfully submitted,



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